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IN THE

Supreme Court of the United States

OCTOBER TERM, 1943.

No. 392

UNIVERSAL OIL PRODUCTS COMPANY,
A CORPORATION,
Petitioner,

vs.

GLOBE OIL & REFINING COMPANY, A CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Preliminary Statement as to the Conflicting Decision.

Notwithstanding the injunction of this Court upon counsel for both sides in presenting Petitions for Certiorari, to disclose fully the real situation (*Furness, Withy & Company, Limited* v. *Yang-Tsze Insurance Association, Limited, et al.*, 242 U. S. 430, 433), petitioner has failed to bring to this Court's attention all the facts surrounding the conflicting decision of the Third Circuit Court of Appeals in *Root Refining Company* v. *Universal Oil Products Co.** (78 F. (2d) 991) which is primarily relied upon

* In this case two appeals No. 5648 and 5546 were consolidated and disposed of by one decision. The Court consisted of Judges J. Warren Davis, Joseph Buffington, and J. Whitaker Thompson. The opinion was written (78 F. (2d) 991) by Judge Davis. These cases will be referred to herein as "the *Root* case." The instant case will be sometimes referred to as "the *Globe* case," and the petitioner as "Universal."

as the ground for the allowance of the writ. Accordingly, respondent presents these facts in the affidavit of J. Bernhard Thiess (*post*, p. 25) and attached Exhibits A and B (*post*, pp. 28-31) presented therewith. From this affidavit and the exhibits it appears:

That in November, 1941, an investigation was ordered by the Third Circuit Court of Appeals into the "relationship and dealings, if any, between Universal Oil Products Company, * * * Morgan S. Kaufman, and former Circuit Judge J. Warren Davis * * *" as bearing on the question of whether the decrees in the *Root* case were invalid by reason of fraud, corruption, obstruction or distortion of justice; that pursuant to said order Thomas Raeburn White, Esq., of Philadelphia, Pennsylvania, was appointed as Special Master to conduct the investigation and render his report; that said Master has taken extensive proofs and now has the matter under consideration, no report having yet been rendered; that shortly after the first oral presentation of the matter of possible fraud in the *Root* case was made to the Court of Appeals for the Third Circuit in June of 1941, counsel for petitioner addressed a letter (Exhibit A attached to the affidavit of J. Bernhard Thiess, *post*, p. 28) to the District Court Judge who had the *Globe* case then under advisement, stating, among other things, that Mr. Reichmann, the writer of the letter and one of counsel presenting the present Petition for Certiorari, had conferred with other counsel for Universal and that they all felt that the District Court should be promptly advised of the oral presentation to the Third Circuit Court, and that counsel preferred that, in reaching its decision, the District Court would pay no attention to the decision of the Circuit Court of Appeals in the *Root* case as a precedent or as having any other effect in the *Globe* case beneficial to Universal* until the matter of the

* Thereby precluding Universal from raising, on appeal, the issue of *res judicata* which, nonetheless, it refers to in the footnote on page three of the petition. It was expressly stipulated (v. VI, p. 3066) that this issue would not be raised on appeal.

investigation should be completely disposed of; that the matter of the investigation has been under consideration by the Master since August 20, 1943, and that it is reasonable to assume that the Master's report will be filed, and action by the Court of Appeals for the Third Circuit taken thereon, as promptly as the nature of the case permits.

We have called to this Court's attention all the facts and circumstances as they at present exist with respect to the status of the Third Circuit Court of Appeals' decision in the *Root* case for two reasons, *first* so that this Court may, if it sees fit, postpone action on the petition until such time as the Court of Appeals for the Third Circuit shall have reached a decision as to whether there is an existing valid decree of that court in the *Root* case, and *second*, so that the Court may be apprised of our intention, pursuant to what we deem to be our duty as expressed in our letter of June 18, 1941, (*post*, p. 32) to the District Court, in the event that fraud and corruption in that decree should be established, to bring the matter to the attention of this Court should the writ of certiorari be allowed.

We also suggest that the petitioner's conduct in requesting the District Court in the *Globe* case not to give the decision of the Court of Appeals in the *Root* case any effect beneficial to petitioner, together with its failure to file a petition with the Seventh Circuit Court of Appeals asking for a rehearing either on the ground of the conflict or on any other ground, precludes the petitioner from invoking the exercise of this Court's discretion in the granting of the extraordinary Writ of Certiorari. Petitioner has forfeited any right to claim in this Court the benefit of a decision which it disclaimed as a factor in its favor in the District Court for reasons of self-interest which it then deemed controlling.

STATEMENT OF THE CASE.

Petitioner's Statement of the Case is such that it needs correcting and supplementing.

Entirely Apart From What May Have Transpired in the Third Circuit, Petitioner Is Guilty of Unclean Hands on the Record Now Before This Court.—Should certiorari be granted, a preliminary question will be presented as to whether petitioner has been guilty of unclean hands with respect to the subject matter of the Dubbs patent. This issue was decided in favor of Universal in the District Court after extensive proofs had been taken on a preliminary hearing, and was not passed upon by the Court of Appeals (v. VII, p. 3576). The misconduct (v. I, pp. 85-460) consisted of Universal's attempts to interfere with, distort, and suppress evidence of prior inventorship of the subject matter of the Dubbs patent by one Otto Behimer, with whom Dubbs was engaged in a Patent Office interference during the period from 1923 to 1931. Universal's investigating agents bribed, and attempted to bribe, employees of The Texas Company, which owned the invention and application for patent of Otto Behimer, in an endeavor to obtain photographs of documents in Behimer's private files; and, when all attempts to obtain the desired drawings and documents failed, Universal clandestinely hired Behimer away from the employ of The Texas Company by offering and paying him the sum of $225,000,00, payable over ten years. Universal thereafter obtained from Behimer a lengthy affidavit setting forth the adverse side of his early work, and also caused Behimer to write a letter to The Texas Company repudiating this work as a reduction to practice of his invention. The decision of the District Court (v. I, pp. 460-3) favorable to Universal, was based on the asserted justification that in seeking to rifle

The Texas Company's files and in bribing its employees Universal was only seeking the truth (Finding No. 7, v. I, p. 464), and that in hiring Behimer it was only acting within its legal rights (Finding No. 12, v. I, p. 465), with no resulting injury either to The Texas Company or to this respondent (Finding No. 11, v. I, p. 465)—a justification expressly refuted by this Court's decision in *Keystone Driller Co.* v. *General Execavator Co.*, 290 U. S. 240.

The Dubbs Patent.

The Dubbs Patent Is Not Infringed by Respondent's Operation.—All the claims of the Dubbs patent (v. VII, p. 3086) are limited to a process where, in the first step, the oil is heated to a cracking temperature in a series of tubes (the B tubes) but without permitting "substantial vaporization" of the oil in these tubes. It is stipulated (v. I, p. 475) that in the respondent's process the oil in the heating and cracking coil (alleged to correspond to the Dubbs B tubes) is vaporized, *i. e.*, converted from liquid to vapor, to the extent of 85% by weight and 95% by volume. The District Court and the Court of Appeals held that this was the "substantial vaporization" prohibited by the claims, and that, therefore, they were not infringed.

Petitioner seeks escape from the holding in the assertion that the Dubbs patent does not use the word "vaporization" to denote the change of state from liquid to vapor, but instead, the "separation" or "liberation" of vapors from liquid. Even this statement of petitioner's asserted meaning for "vaporization" is uncertain, for petitioner contended in the District Court that Dubbs did not mean *any* "separation" but rather a special kind of "separation." Thus petitioner's position was (v. III, p. 1363) that "vaporization" in the Dubbs patent does not mean the molecular separation which occurs when molecules of

liquid become molecules of vapor and form bubbles in the liquid or evaporate at its surface, nor the passing off of vapor as steam passes off from a teakettle, nor the segregation of vapors from liquid. According to petitioner the word means (v. III, pp. 1363-4) "the liberation or freeing of *bubbles* of vapor entrained in a liquid phase, so that these bubbles may coalesce to form a continuous vapor phase." There is not a hint in the Dubbs patent of any such remarkable definition. In developing its theory petitioner contended (v. II, p. 721; v. III, p. 1365) that such "liberation" does not occur so long as the liquid and vapors are in the condition of a "foam" (where the liquid phase is continuous) but that it does occur when the foam "breaks" into a "spray" or when the velocity is so slow that the vapors become segregated above the liquid (the vapor phase then becoming continuous). Nothing is expressed or intimated in the Dubbs patent about any such conditions. The words "foam", "spray" and "velocity" do not occur in the specification (v. VII, pp. 308-9).

The specification of the Dubbs patent does not contain any definition of the terms of the art, but uses words in their accepted sense. The word "vaporization" is commonly used in the oil cracking art and in the sciences of physics and chemistry. Every high-school boy who studies these sciences learns, if he did not already know, that "vaporization" of a liquid means its change of state from liquid to vapor. Both courts below concurred in finding that the word means this change of state. They both found that no special or unusual meaning of the word was indicated in the Dubbs patent.

The accepted meaning of the word "vaporization" in Dubbs' claims is confirmed by the file-wrapper history of his patent.

The original claims (v. IV, pp. 1515-6) stated that "generated vapors" were present in the heating coil, with-

out, however, stating whether this generation was substantial or insubstantial. These claims were rejected and cancelled (v. IV, pp. 1519-21), and the claims finally submitted were limited by the requirement that the oil be heated but without "substantial vaporization" (v. IV, pp. 1536-40; 1543). The "generated vapors" of the original claims is the "vaporization" of the allowed claims, but in the latter the amount of such "generated vapors" is limited quantitatively to an insubstantial amount.

Up to the final amendment the Patent Office had consistently rejected all the claims submitted, none of which then contained the limitation to "without substantial vaporization." Dubbs was contending that his process distinguished from the prior art cited against him on the ground that in his process *all* the residue formed in the cracking operation was withdrawn and not returned to the system, whereas in the prior art references all or part of the residue was recirculated (v. IV, p. 1533). The Patent Office refused to recognize the asserted distinction and rejected the claims (v. IV, p. 1535).

The British Trumble patent No. 15084 of 1915 (v. VII, p. 3557), which was one of the prior art patents upon which Dubbs stood rejected just prior to the final amendment (v. IV, pp. 1526, 1535), discloses a cyclic cracking process where the oil is heated in the coil so that vaporization occurs therein resulting in a foamy mixture of oil and vapors, just as in respondent's process. In Trumble part of the residue is withdrawn and the rest is recirculated through the coil mixed with the clean condensate or reflux from the dephlegmator.

Upon suffering rejection of his claims on Trumble and other prior art patents, Dubbs rewrote and amended his claims and inserted in all of them for the first time the limitation to heating the oil in the first step "but without substantial vaporization". The claims thus limited were

allowed. Two of these claims, namely, 4 and 5 (v. IV, p. 1538), do not call for the total withdrawal of residue and its non-return to the system, and therefore do not distinguish from Trumble save by their limitation to heating the oil "but without substantial vaporization", and that phrase distinguishes only if "vaporization" be given its accepted meaning to denote the change of state from liquid to vapor in the coils. As "vaporization" in Dubbs' claims 4 and 5 necessarily means the generation or formation of vapors from liquid in order to distinguish them from Trumble, it necessarily follows that the word has the same meaning in all the other claims.

Confirming the fact, evident on the face of the Dubbs patent in suit, that to Dubbs as to everyone else, "vaporization" denotes the conversion of liquid into vapor, is Dubbs' later issued patent No. 1,686,654 (v. VII, p. 3468), the application of which was a continuation of an application filed prior to that of the Dubbs patent in suit. In this later patent, Dubbs also imposed a similiar claim limitation which prohibited substantial vaporization in the heating coil, and stated in his specification (v. VII, p. 3471, lines 55-57) that the oil in this coil was heated "without being converted, to any great amount, into vapors".

The Illustrative Run Does Not Compel Petitioner's Unheard-of Meaning for "Vaporization."—As filed, the Dubbs application for the patent in suit contained no temperature or pressure conditions. The illustrative run containing these conditions was added in the first amendment (v. IV, pp. 1520-1) at a time considerably before the claims were limited (v. IV, p. 1536) to a process where the oil is heated to a cracking temperature in a coil but without permitting "substantial vaporization" therein. When this limitation was inserted the upper temperature range of the illustrative run became no longer appropriate if no more than the approximate pressure of 100 pounds also given therein

were employed in operating the process, because that pressure would be insufficient at that temperature (860° F.) to prevent "substantial vaporization" of the oil. However, it was well within the skill of the art to increase the pressure sufficiently to prevent vaporization even at this higher temperature. At the lower temperature range, and even without exceeding the pressure of approximately 100 pounds given in the patent, an operation could be conducted in accordance with the patent teachings and without substantial vaporization of the oil (v. III, p. 1088).

In Petitioner's Meaning of the Word "Vaporization", the Dubbs Patent is Wholly Invalid for Lack of Disclosure and for Indefiniteness.—The only way to prevent separation of bubbles of vapor from liquid in a coil is to flow the stream through the coil at sufficient velocity to keep them intimately commingled as a foam (v. III, pp. 1097-8), but the Dubbs patent contains no express or implied teaching of velocity, much less of the amount of velocity required. Petitioner's expert could not give a minimum velocity which would prevent "separation" of vapor from liquid in the B tubes of the Dubbs patent (v. II, pp. 766-7). Nor does the Dubbs patent say anything about entraining vapors "in a liquid phase," or about preventing the coalescing of bubbles in a "continuous vapor phase," or about permitting a "foam" but prohibiting a "spray".

Petitioner's theory likewise conflicts with the word "substantial" in the Dubbs claims. Vapors "separate" from liquid because they are lighter than the liquid (v. III, p. 1097). There can be no such thing as a "substantial" number of bubbles remaining unliberated while an "insubstantial" number obey gravity and pass on up and out of the liquid (v. III, pp. 1095-6). Petitioner's expert witness conceded that a determination of the conditions permissible (*i. e.*, when a "foam" becomes a "spray") within his interpretation of the word "vaporization" involves

calculations, and that he did not know whether these calculations could have been made as of 1919, when the Dubbs application for patent was filed (v. II, p. 724). He also admitted that as of that year no one could predict exactly where the line of demarcation was between the alleged Dubbs conditions and conditions which would not infringe Dubbs' claims if "vaporization" be given petitioner's meaning (v. II, p. 699).

On petitioner's own proofs, the process defined in the claims of the Dubbs patent, *i. e.*, where the oil is heated in the coil but without "substantial vaporization" therein, has never been used commercially if the word "vaporization" be given its accepted meaning.

The Dubbs Patent Discloses and Claims a Limited Type of Cracking Process Which Respondent Does Not Use.— Cracking has been known to the oil refining art since about 1860 and was never controlled by any basic patent (*Standard Oil Company, et al.* v. *United States*, 283 U. S. 163, 167). As stated by the Court below, the field was "far from a virgin one" when Dubbs entered it (v. VII, pp. 3577-8). The Dubbs patent, accordingly, is directed to a specific type of cracking process; it discloses a liquid phase two-stage cracking process where the oil is brought to the cracking temperature in 4-inch B tubes, where the cracking reaction is initiated but "without substantial vaporization" of the oil in these tubes, and is then conducted to unheated or lightly-fired 10-inch C tubes, wherein it is cracked by its pre-acquired heat, and substantially vaporized, and wherein the carbon resulting from the cracking operation is deposited (v. III, pp. 1073-5; District Court's Findings Nos. 10, 11, v. VI, pp. 3054-5). The carbon is not deposited in the same part of the apparatus in which the cracking heat is imparted to the oil. This is the heart of Dubbs' invention whereby he solved the carbon problem in cracking operations. This

division of the cracking process into two stages is made possible because two factors, namely, temperature and time, enter into the cracking reaction (v. III, pp. 1060-1). Dubbs imparts the cracking temperature in his B tubes and obtains his time factor in the C tubes where the major cracking of the process is carried out, and the resulting carbon is deposited. The deposit of carbon in the C tubes does not interfere with the heating of the oil as it did in the prior art, where (with the exception of Behimer, *post*, p. 12), the cracking operation was conducted in the same vessel to which the cracking heat was applied.

The return of reflux to the inlet of the B tubes, rather than to the C tubes, which is what plaintiff calls "clean circulation"* has nothing to do with the solution of the carbon problem, save as it tends to prevent cooling of the oil in the C tubes where cracking temperatures are to be maintained (v. III, p. 1090). Dubbs' solution of the carbon problem by bringing the oil to a cracking temperature but without permitting any substantial cracking, or consequent carbon formation, in a heating zone, and thereafter conducting the cracking with consequent deposition of tons of carbon in an unheated or lightly-fired zone, achieved great commercial success, but it is, admittedly, not a process which respondent uses. Respondent practices the old prior art process of both heating a clean selected stock in a coil and cracking it therein to a point short of that where carbon would be deposited, and stopping the cracking reaction beyond the coil, so that very little carbon is made anywhere in the system (v. III, pp. 1126, 1130).

* The step of withdrawing all the residue formed in the cracking operation and not returning it to the system, was old in the prior art patents to Benton, British, No. 1922 of 1887 (v. VII, p. 3527), Pielsticker U. S. No. 477,153 (v. VII, p. 3126), and British patent No. 1308 (1891) (v. VII, p. 3531), Hall U. S. No. 1,175,910 (v. VII, p. 3200), Ellis, No. 1,396,999 (v. VII, p. 3351), Alexander U. S. No. 1,407,619 (v. VII, p. 3364), and Greenstreet U. S. No. 1,740,691 (v. VII, p. 3476). Hence, this step is no part of "clean circulation."

Invalidity.—Every step of the Dubbs process was disclosed in the prior filed application of Otto Behimer (v. VI, pp. 2653-2659), which ultimately resulted in patent No. 1,883,850 (v. VII, p. 3494). The so-called clean circulation step of the Dubbs patent, *i. e.*, the step of returning reflux to the inlet of a cracking or heating coil in a process where the residue is continuously withdrawn and not returned to the system, is also fully disclosed in Pielsticker British patent No. 1308 of 1891 (v. VII, p. 3531) and United States patent No. 477,153 (v. VII, p. 3126), Ellis No. 1,396,999 (v. VII, p. 3352), and Hall No. 1,175,910 (v. VII, p. 3200). No one of these patents was cited against the Dubbs application during the Patent Office prosecution. All of them were held to disclose "clean circulation" by the Tenth Circuit Court of Appeals in *The Texas Company v. Anderson-Prichard Refining Corp.*, 122 F. (2d) 829, 834.

The Egloff Patent.

The Egloff patent (v. VII, p. 3094) contains an inadequate disclosure of a pressure distillation two-step cracking process (v. III, pp. 1104-5) which is the exact antithesis of the respondent's coil cracking process (v. III, p. 1141). In the light of Egloff's specification, his claims are not infringed by respondent's process. Egloff intends to conduct all his cracking in the liquid phase in the drum or expansion chamber (v. III, pp. 1108-10), whereas respondent conducts substantially all its cracking in the mixed phase in a mile-long coil, and checks the cracking operation beyond the exit from this coil (v. III, pp. 1119, 1127). The Egloff patent contains no operating data from which a man skilled in the art could conduct a useful process (v. III, p. 1110). Egloff's supposed advance over Dubbs is the separate heating of the reflux and the charging stock. This, however, constitutes, on petitioner's own admission, a step backwards in the art because the combined heating of reflux and charging stock is claimed by

petitioner to be an advantage in Dubbs (v. II, pp. 657-8). If Egloff's claims be construed to read on the respondent's operation they are anticipated by the disclosures of Alexander No. 1,407,619 (v. VII, p. 3364) and Greenstreet No. 1,740,691 (v. VII, p. 3476), both of which disclose fully respondent's step of making *in situ* a clean charging stock for the cracking coil.

While the District Court held that the Dubbs patent was valid and the Egloff patent invalid (v. VI, p. 3051), the Court of Appeals did not find it necessary to pass on these issues. If this Court should grant the Petition for Certiorari, respondent will contend that the Dubbs and Egloff patents are both invalid. Under the rule of *Stelos Co.* v. *Hosiery Motor-Mend Corp. et al.*, 295 U. S. 237, and *Langnes* v. *Green*, 282 U. S. 531, 535, respondent is not required to cross-petition for certiorari in order to urge the invalidity of the patents in suit.

ARGUMENT.

We shall here address ourselves to the alleged grounds relied on for the allowance of the writ as set forth on pages 21-2 of the Petition.

(1) *Even Assuming a Valid Decision in the Third Circuit, There Is No Basis for the Allowance of the Writ.*—The conflict primarily relied on, considered in the light most favorable to petitioner, is on a very narrow question of fact, *i. e.*, the meaning of a common English word used in the Dubbs patent. We submit that there is not thus presented the sort of case which moves this Court to grant the extraordinary Writ of Certiorari, even though there were the clean-cut conflict which the petition suggests.

But as a matter of fact the petitioner is in no position to claim the benefit of a conflict, for two reasons, *first*, it requested the Seventh Circuit District Court to "pay no attention" to the Third Circuit Court of Appeals decision in the *Root* case, and, *second*, it presented to the Seventh Circuit Courts a different definition of "vaporization" to that which it presented to the Third Circuit Courts. We have pointed out (*ante*, pp. 2-3) the circumstances by which Universal is precluded on the first ground. We now proceed to explain the second.

In the *Root* case, as appears from Judge Davis' opinion (78 F. (2d) 991), petitioner advanced, and the Court adopted, the contention, that "without substantial vaporization" in the Dubbs patent meant that the physical condition of the liquid vapor mixture in the B tubes would be (p. 997) "a spray, a froth, a spit, a foam". Thus, in 1935, petitioner persuaded the Third Circuit Courts that "without substantial vaporization" included a "spray" as well as a foam.

But before the Seventh Circuit Courts, petitioner changed its position, and insisted that the dividing line between what was and was not a condition where "substantial vaporization" is "prevented" in the B tubes is that between a permitted "foam" and a prohibited "spray". Petitioner was driven to this position in order to avoid the dilemma in which its Third Circuit definition placed it, *i. e.*, the inescapable conclusion that if "without substantial vaporization" meant "without substantial separation of vapor bubbles from a body of liquid" and nothing more than that, then you could vaporize 50%, 75%, 95%, *and even 100%* of the oil in the coil (v. III, pp. 1094-5) without ever reaching a condition where "substantial vaporization" was present. Hence, petitioner found it necessary, in the Seventh Circuit, to fix some point short of 100% vaporization of the liquid at which the requirement of the claim limitation would be satisfied. Petitioner arbitrarily placed this point at 99.9% vapor to .1% liquid, this being the point at which petitioner (for no ascertainable reason whatsoever) asserted (through its expert, v. III, p. 1365) that a "foam" breaks into a (substantial?) "spray".

Passing the question of whether this Court should occupy its time with such absurdities, the point we now make is that petitioner, having abandoned the definition of "vaporization" which it successfully advanced in the *Root* case, is in no position now to say that that case was rightly decided. Thus, although the ultimate conclusions of the two circuits are in conflict, petitioner is in the position of having admitted that the Third Circuit decision was wrong because based on a wrong premise. In these circumstances petitioner can claim no benefit or advantage from the conflict in decisions.

The conflict as to the expired, wholly useless, and never-used, Egloff patent is not of sufficient importance in itself to warrant the allowance of the writ.

(2) *The Alleged Matter of Public Interest in Resolving the Conflict.*—In view of the fact that both the Dubbs and Egloff patents have expired and that the ground of decision in the Third Circuit is so clearly erroneous on its face, and is based upon a contention which petitioner has now repudiated, it is submitted that the saving of petitioner's time and money in prosecuting other actions is not sufficient ground for the allowance of the extraordinary Writ of Certiorari. If the petition for certiorari were granted merely to avoid litigation in other circuits this Court would habitually grant, rather than deny, such petitions.

(3) *The Court of Appeals for the Seventh Circuit, in Determining the Meaning of the Word "Vaporization" as Used in the Claims of the Dubbs Patent, Employed the Only Proper Method.*—The Seventh Circuit Court of Appeals affirmed the District Court's finding that the word "vaporization" was a word commonly used both by scientists and by the laity to indicate a change of state from liquid to vapor. The lower court arrived at this conclusion after hearing the oral testimony of numerous engineers and scientists and after considering at length the meaning given to the word by dictionaries and textbooks. On page 14 of the Petition it is stated in a footnote that:

> "Other dictionaries and textbooks support the meaning [of 'vaporization'] advanced by petitioner."

The example given is "Elements of Physics", by Professor Hoadly. It is perfectly obvious that this author's description of the mechanics of vaporization is as applicable to what transpires in respondent's coil, where vapors and liquid are intermingled in a foam, as where vaporization is taking place where the liquid is in a quiescent condition. In either event the molecular phenomenon is that of change of state accompanied by separation or liberation of the molecule of vapor from the liquid, whether this separation occurs in the bubbles of a foam as in respondent's cracking

coil, or from the surface of a glass of water (v. II, pp. 808-9; III, p. 1070). It is perhaps for this reason that the Court of Appeals for the Seventh Circuit said that "substantial vaporization" occurs in the respondent's coil even though petitioner's definition of "vaporization" be accepted. To escape such a conclusion, petitioner insisted in the lower court that vaporization in the Dubbs patent did not mean this *molecular* separation or liberation of vapor from liquid (v. III, p. 1363).

The opinion of the District Court, which was adopted on this point by the Court of Appeals, shows that the meaning of "vaporization" in the patent was not arrived at *in vacuo*, as the petition asserts, but was the result of a careful analysis of all the process teachings in the patent specification, as well as of the testimony of the witnesses and the meaning of the word in ordinary usage.

Petitioner does not claim that Dubbs, in the specification of the patent in suit, made his own vocabulary, imparting a new meaning to "vaporization". Its argument is based:

(a) upon an alleged incompatibility between the conditions given in an amendment to the specification and the limitation later imposed in the claims,

(b) upon the asserted fact that the industry never practiced a process where substantial vaporization of the oil in the heating coil is prevented, and

(c) that in the demonstration of the process while the application was pending, and before the claims were limited, substantial vaporization was permitted in the coil.

It is apparent that no one of these grounds is a valid reason for changing the meaning of a word used in a patent. Under such criteria the claims would be measured by what is asserted to be the invention, rather than the invention being measured by the claims, which is the rule so often stated by this Court. *Minerals Separation Limited et al.* v. *Butte & Superior Copper Company, Limited*, 250

U. S. 336, 347; *Motion Picture Patents Company* v. *Universal Film Mfg. Company, et al.*, 243 U. S. 502, 510; *White* v. *Dunbar*, 119 U. S. 47, 52. Furthermore, even if sound, none of these factors can be regarded as *affirmatively* showing any alternative meaning for the word "vaporization." At most they only tend to negative the position that the word has its accepted meaning in the patent. But inferences that the word does not mean the generation of vapors are not substitutes for the necessary affirmative teaching to the art of what it does mean, and of what condition is, in the patentee's view, prohibited by the limiting clause "substantial vaporization prevented." In *Minerals Separation Limited et al.* v. *Butte & Superior Copper Company, Limited*, 250 U. S. 336, 350, this Court said that an "implied and vague description" could not be held to satisfy the requirements of the patent statutes.

Furthermore, if the word "vaporization" in Dubbs' claims be given petitioner's meaning, the patent itself becomes invalid for indefiniteness. Prevention of "vaporization" in petitioner's sense means maintaining, by high velocity, a condition of turbulence in the coil so that liquid and vapor are intimately mixed together as a foam, and preventing this "foam" from becoming a "spray." There is no teaching of a turbulent flow in Dubbs' patent; there is not a word that indicates any velocity of the stream. Nothing is said about "foam" or "spray" and no one could possibly ascertain at what point in a cracking coil a "foam" becomes a "spray."

The District Court said in its opinion (v. VI, p. 3049):

> "If * * * the number and the length of the B tubes was such as to require forcing the oil there through at high velocity, and this velocity was necessary to prevent 'substantial vaporization' therein, the patent is wholly silent upon these critical factors of the invention."

The interpretation adopted by the Seventh Circuit District Court and Court of Appeals is wholly in conformity

with the rules of construction of letters patent laid down by this Court.

(4) *The Court of Appeals Properly Restrained Petitioner From Adopting That Construction of Its Claims Necessitated by Exigencies Created by the Nature of the Respondent's Operation.*—The application for the Dubbs patent as filed did not contain the word "vaporization" (v. IV, pp. 1511-7). It was first used in an amendment (v. IV, p. 1520), and as thus used, and also in the final claims, the record leaves no doubt of the fact that Dubbs used it in its ordinary and accepted sense to denote the change of state from liquid to vapor. This also appears from Dubbs' use of the word "vaporization" in his subsequently issued patent No. 1,686,654,* (v. VII, p. 3468) whose application was the continuation of an application which was copending with that of the Dubbs patent in suit. In this other patent Dubbs not only made perfectly clear the fact that the clause in the claims requiring "sufficient pressure to prevent the vaporization of any substantial portion" of the oil is the same thing as the specification statement that the oil, by being kept under pressure, "can be subjected to a higher heat without being converted in any great amount into vapors", but also gave his reason for wishing to prevent this vaporization. In this respect he explained to the Examiner that:

> "* * * trouble will occur if substantial vaporization takes place in the coils. To prevent the precipitation of carbon due to vaporization the applicant maintains a high pressure on the oil in the coil."†

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* In *Weber Electric Co.* v. *E. H. Freeman Electric Co.*, 256 U. S. 668, confirmation of the sense in which the patentee used the word "telescopic" was found in the use of the same word in a subsequently issued patent of the same patentee.

† Although this passage in the exhibit was designated for printing (v. VI, p. 3083), through a printer's error it was not reproduced in the printed record. If the petition should be granted a motion suggesting diminution of the record will be necessary in order to bring before this Court the file wrapper of this Dubbs patent, No. 1,686,654.

The Court of Appeals for the Seventh Circuit, in stating that (v. VII, p. 3580) "an applicant who used words of common meaning and finds they do not cover a subsequently created structure will not be permitted to place a new or different meaning that will cover said subsequently appearing structure" was applying the same wholesome rule laid down by the Second Circuit Court of Appeals in *Hookless Fastener Co.* v. *G. E. Prentice Mfg. Co.*, 68 F. (2d) 848 (C. C. A. 2), where the Court said (p. 851):

> "• • • But this language was chosen by the inventor and made by him a part of his contract with the government. Liberality of construction does not go to the point of permitting him, or in this case his assignee, to fix the scope of the patent in the way most advantageous to meet the exigencies of the present suit by giving to his language, the one of two equally possible meanings* which is for the present most favorable. *Parker* v. *Sears*, 18 Fed. Cas. page 1159, No. 10,748. It must be construed in accordance with rules of construction applicable to contracts generally. • • • And language of doubtful meaning is to be taken most strongly against the one who used it."

Certainly the *Globe* case and the *Hookless Fastener* case are not in conflict with any applicable decision of this Court.

(5) *The Claims of the Dubbs Patent Are Not Susceptible of Two Interpretations, and Hence There Is No Choice Between One Which Will Sustain and the Other That Will Devitalize the Patent.*—We have shown that the Dubbs patent itself, its file wrapper history and Dubbs' use of the word "vaporization" in his copending application and subsequently issued patent permit but one meaning, and that the accepted one, for the word "vaporization" in the

* There are not two possible meanings for "vaporization." What petitioner frequently refers to as "respondent's meaning" is that universally accepted in dictionaries, text books, and common usage in the art.

claims of the patent in suit. It is not true that the Court's adoption of this meaning in the construction of the claims resulted in an emasculation of the patent. While it is true that, according to petitioner's proofs, none of its licensees troubled to give effect in their commercial operations to the claim requirement against "substantial vaporization" in the coil, nevertheless there is undisputed testimony in the record that a liquid phase process practiced in accordance with the claim limitation would be very useful and valuable (v. III, p. 1151). Furthermore, giving petitioner's meaning to the word "vaporization" in Dubbs' claims, the patent would not be "vitalized" but would be wholly devitalized and invalidated, for in such event: (a) the claims would mean the same after as before the final carrying amendment (*Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211); (b) claims 4 and 5 of the Dubbs patent would not distinguish from the prior art Trumble patent, and the remaining Dubbs claims would differ therefrom merely in degree (*Smith* v. *Nichols*, 88 U. S. 112); and (c) the patent would be wholly indefinite, for nothing is therein suggested to the man skilled in the art, by which he could know, or could learn by experiment, how to practice a process without substantial "liberation" or "separation" in petitioner's sense, of vapors from liquid in the cracking coil (*Minerals Separation, Ltd.* v. *Butte & Superior Mining Co.*, 250 U. S. 336, 350; *United Carbon Co.* v. *Binney & Smith Co.*, 87 L. Ed. 158, 163; *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U. S. 34, 38). Under these circumstances, the rule relied upon by petitioner has no application, and the failure of the Court of Appeals to apply it, furnishes no ground for the allowance of the Writ of Certiorari.

(6) *Petitioner's Sixth Ground Merely Begs the Question.*—Little need be said in answer to ground 6 of the reasons relied on by the petitioner for the allowance of the

writ. It is here asserted that "the putative infringing process exhibits the whole of the re-submitted claim." This would be true only if "vaporization" in Dubbs' claims were given the wholly unjustified meaning ascribed to it by petitioner. If the word be given the meaning compelled by Dubbs' own usage and the file-wrapper estoppel and by the absence of any indication in the patent of any other than its accepted meaning, then, on petitioner's own admission, the alleged "putative infringing process" does not infringe Dubbs' claims. In determining which meaning is to be given to the word, obviously the common usage in the art, and in the patentee's subsequently issued patent, the absence of any indication of a special meaning in the patent in suit, the file-wrapper history, and the effect of the limitation as serving to distinguish the claims from the prior art Trumble patent, are the proper criteria, and their use is not in conflict with any decision of this Court, but is in precise agreement with *Weber Electric Co.* v. *E. H. Freeman Electric Co.*, 256 U. S. 668, *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U. S. 126, 136, and *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 444.

(7) *Being for an Improvement in a Highly Developed Art, the Dubbs Patent Is Even Less Entitled to a Construction Which Would Remove the Limitation Which the Inventor Himself Inserted in the Claims to Obtain Their Allowance.*—Under its point 7, the petitioner has seized upon a statement in the opinion of the Court of Appeals that (v. VII, p. 3582): "At best the invention was in the nature of an improvement and the language of the claims should be construed accordingly." Here the Court was refusing recognition to petitioner's argument that because of alleged commercial success of a process other than that defined by the claims, the Court should construe the claims to conform to the commercial practice. Undoubtedly such a construction would, as the Court indicated, be wholly in-

applicable if applied to an improvement patent, and the fact that it would be just as inapplicable if sought to be applied to a basic patent is doubtless beside the point.

(8) *As to the Egloff Patent.*—Even though the Court of Appeals' opinion with respect to Egloff were as stated in petitioner's point 8, no ground for the grant of certiorari would be thereby presented. As a matter of fact, however, the Court's ruling was that respondent did not infringe the Egloff patent (v. VII, p. 3584) for reasons pointed out in its brief. No further elaboration was evidently deemed necessary, and it is beyond question that a finding by a Court of Appeals of non-infringement of a patent, for reasons not elaborated, cannot under any circumstances be said to be in probable conflict with the applicable decisions of this Court. It should also be noted that the Court of Appeals neither adopted nor disapproved of the lower court's opinion holding invalidity of the Egloff patent for lack of utility.

Conclusion.

It is respectfully submitted that the Petition for Certiorari should be denied.

J. Bernhard Thiess,
Thorley von Holst,
Sidney Neuman,
Robert W. Poore,
Attorneys for Respondent.

IN THE

SUPREME COURT OF THE UNITED STATES.

No. 392.

UNIVERSAL OIL PRODUCTS COMPANY,
A CORPORATION,
Petitioner,

vs.

GLOBE OIL & REFINING COMPANY,
A CORPORATION,
Respondent.

AFFIDAVIT OF J. BERNHARD THIESS.

STATE OF ILLINOIS, }
COUNTY OF COOK. } ss.

J. BERNHARD THIESS, being first duly sworn, on oath deposes and says:

I am a resident of the City of Chicago, State of Illinois, and am a member of the Bar of this Court. I am counsel for Respondent in the above entitled cause, and I was counsel of record for the defendant-appellant in the cases of *Root Refining Company* v. *Universal Oil Products Company*, Appeal Nos. 5648 and 5546 in the United States Circuit Court of Appeals for the Third Circuit. These cases involved the same patents as those asserted in the above entitled cause, and were decided on June 26, 1935, in favor of Petitioner herein. The opinion of the Court was written by Judge J. Warren Davis, and concurred in by Judges Joseph Buffington and J. Whitaker Thompson. The conflict between the Third and Seventh Circuit decisions is

the ground primarily relied on in the Petition for Certiorari filed herein as the reason for the allowance of the Writ.

In the 1941 March session of the District Court of the United States of America for the Eastern District of Pennsylvania, there was returned an indictment, No. 8969, against said Judge J. Warren Davis and against one William Fox and one Morgan S. Kaufman, charging conspiracy to obstruct justice and to defraud the United States in the matter of William Fox, Bankrupt. The cause came on for trial on May 19, 1941, and was concluded on May 29, 1941, the jury having failed to reach a verdict. During this trial certain proofs were adduced upon the strength of which, on June 5, 1941, an oral application was made, and on June 20, 1941, a Petition was filed, before the Court of Appeals for the Third Circuit, requesting that court to order an investigation into the question of whether its decrees in the said cases of *Root Refining Company* v. *Universal Oil Products Company* were invalid because of fraud. The said Petition was subscribed by Arthur C. Denison, Thorley von Holst, and the affiant, as *Amici Curiae*, and not as representing the Root Refining Company, that company having theretofore, to-wit, on or about January 24, 1939, settled its case with Universal Oil Products Company.

On June 16, 1941, while the case of *Universal Oil Products Company* v. *Globe Oil & Refining Company*, now before this Court, was pending in the District Court, counsel for Petitioner herein addressed a letter to District Judge Holly asking him to "pay no attention to the decision of the Circuit Court of Appeals [for the Third Circuit in the *Root* case] as a precedent, or as having any other effect in the Globe case beneficial to Universal, until this matter [the said investigation] has been completely disposed of." A copy of said letter and a copy of counsel for respondent's reply thereto are marked respectively Exhibits A and B and are attached hereto.

On November 26, 1941, the Court of Appeals for the Third Circuit, sitting *en banc*, entered its order in the said cases of *Root Refining Company* v. *Universal Oil Products Company*, by which *inter alia* it appointed Thomas Raeburn White, Esq., of Philadelphia, as Special Master

> "* * * with authority to examine, investigate and to make and report to this court his findings and conclusions concerning the relationship and dealings, if any, between Universal Oil Products Company, the plaintiff-appellee above named, Morgan S. Kaufman, and former Circuit Judge J. Warren Davis, and any and all persons acting for or on behalf of any of them in connection with the above entitled causes and the entire subject matter of the prosecution and disposition of the said causes and in particular whether there was in connection therewith such fraud, corruption, obstruction or distortion of justice as tainted and invalidated the judgments rendered by this court in the above entitled causes on June 26, 1935."

Pursuant to the authority of said order, the said Special Master proceeded with the taking of proofs, and these have now been concluded. Testimony was taken comprising over four thousand typewritten pages, and over two hundred and eighty exhibits were received in evidence. Briefs on behalf of Universal Oil Products Company and on behalf of those appearing as *Amici Curiae* have been filed. The case has been under consideration by the Master since August 20, 1943, and his report will doubtless be filed as promptly as the magnitude of the task confronting him permits. Action by the Court of Appeals may be expected reasonably soon thereafter.

J. Bernhard Thiess.

Subscribed and sworn to before me this 19th day of October, 1943.

Anne E. Ryan,
Notary Public.

EXHIBIT A.

PAM, HURD & REICHMANN
231 S. La Salle Street
Chicago, Illinois

June 16, 1941.

Honorable William H. Holly,
Judge of the United States District Court,
United States Court House,
Chicago.

re Universal Oil Products Company vs.
Globe Oil & Refining Company—
Equity No. 10744.

DEAR JUDGE HOLLY:

The subject matter of this letter did not come to my notice until the latter part of last week, due to my absence from Chicago. I had no notice of the hearing referred to, and did not attend the same. A copy of the letter hereinafter referred to, and a resume of the proceedings outlined, were sent to me by Mr. Hall immediately, but did not reach me until my return to Chicago on Thursday last.

I have given this matter earnest consideration since it was called to my attention, and have conferred with my associates in the above case over the telephone concerning it. We all feel that I should promptly advise you of the same, and of our suggestions, while you still have the above case under consideration.

On June 3rd, counsel for Universal Oil Products Company in the Root Refining Company case, received a letter addressed to Messrs. Haight, Hall, Thomas and Morris, from counsel representing the Globe Oil & Refining Company in the above suit pending before you, to the effect that they would appear before the Circuit Court of Appeals for the Third Circuit on June 5th, and "present the question of whether or not" it should institute some sort of an investigation regarding the appeal in the Root Refining Company case, and "the connection of Morgan S. Kaufmann therewith."

The suggestion was said to be based on the fact that Judge Davis (who wrote the opinion in the Root case, speaking for himself and Judges Buffington and Thompson, his associates), and Morgan S. Kaufmann had been recently tried on charges involving the bankruptcy of one Fox, and that it was brought out during that trial that for a certain period, during a part of which the Root case was pending before the Circuit Court of Appeals, Kaufmann had been under retainer as attorney for Universal.

The interest of counsel signing the letter was said to be that they represented the Globe Oil & Refining Company, and other concerns, against whom the decision in the Root case was being asserted as a precedent and as *res judicata*.

Counsel for Universal, to whom this letter was addressed, appeared before the Court and said that while the relationship between Kaufmann and Universal was entirely proper, and the decision in the Root case had been justly arrived at, yet Universal had no objection to any investigation the Court might deem it proper to institute; and, furthermore, in view of the fact that Messrs. Davis and Kaufmann were under the above mentioned charges, Universal was entirely willing to have the Court, as presently constituted (none of the members of which had participated on the appeal in the Root case) reconsider the Root case on the record and old briefs, supplemented if desired, by oral argument, and, pending the reconsideration, to vacate the decision of the old Court affirming that of Judge Nields, if the Court deemed it best so to do.

Counsel for Globe, while not rejecting the offer, did not accept it.

The upshot of the matter was that the Court suggested to counsel for Globe that if they desired they file some formal paper specifying exactly what remedy they wanted, and which they thought the Court had authority to give, and Universal would then be given an opportunity to reply. Up to the present writing, no further steps have been taken by counsel for Globe.

Under the circumstances, and especially in view of Universal's offer to have the old decision reconsidered, counsel for Universal would prefer that in reaching your decision

in the Globe case, you pay no attention to the decision of the Circuit Court of Appeals as a precedent, or as having any other effect in the Globe case beneficial to Universal, until this matter has been completely disposed of. We desire, however, that full weight and credit be given to Judge Nields' decision, if, in the determination of the case, you wish to consider it.

I am sending a copy of this letter to counsel for Globe.

Very respectfully yours,

(Sgd.) A. F. REICHMANN.

EXHIBIT B.

June 18, 1941.

Honorable William H. Holly,
United States District Court,
United States Courthouse,
Chicago, Illinois.

Re: Universal Oil Products Company v. *Globe Oil & Refining Company, Equity No. 10,744.*

DEAR JUDGE HOLLY:

In view of the letter to you of June 16th from Mr. Reichmann, and its lack of completeness concerning the procedure before the Third Circuit Court of Appeals, I am enclosing herewith a copy of the Petition and Brief *Amici Curiae* which we are today serving upon counsel for Universal and transmitting to the Court of Appeals for the Third Circuit.

I think that this document makes clear to you the basis of our application, and why it was made to the Third Circuit Court of Appeals, and that it also makes clear that in the application made to that Court, we were not acting on behalf of Globe Oil & Refining Company with respect to any matter which is now pending before you, or which properly should have been presented to you in the first instance. The presentation to the Third Circuit Court of Appeals on June 5th was informal and oral, and the Court then directed that the application be put in formal shape and filed. The enclosure herein is now being filed in that Court pursuant to that direction. Since Mr. Reichmann has now called this matter to your attention, I believe it proper to give you a complete statement thereof as contained in our Petition and Brief, *Amici Curiae*.

With regard to Universal's offer for reargument of the *Root* case, Mr. Reichmann's letter says "Counsel for Globe, while not rejecting the offer, did not accept it." As a matter of fact, we made clear to the Court of Appeals for the Third Circuit, at the hearing, that Root had settled its case, that we no longer represented Root, and had not

represented it either in the settlement or in any manner since then, and that, consequently, there was no counsel present then authorized to speak on behalf of Root in respect to the offer.

Mr. Reichmann's letter (p. 2, second full paragraph) says that "Counsel for Universal * * * appeared before the Court and said that while the relationship between Kaufmann and Universal was entirely proper * * *." In this, Mr. Reichmann is mistaken. No such statement was made at the June 5th hearing by Universal's counsel. My statements in this and the preceding paragraph, are in accordance with the complete Stenographic Transcript of the June 5th proceedings. Evidently, Mr. Reichmann's associates did not fully inform him.

The case of Globe Oil & Refining Company is submitted to your Honor on the merits. Its counsel have neither the power nor the inclination to submit its case to the Third Circuit on the old and insufficient record in the *Root* case, nor to assume control thereof. The Petition-*Amici Curiae* presented in the Third Circuit could not possibly affect the *Globe* case unless it should finally appear that the Root decision was tainted by corruption or unlawful influence accomplished or intended, in which event, every defendant, including Globe, against whom the *Root* case has been asserted, would be entitled to a dismissal of the Complaint for unclean hands.

Whether or not this Court's decision in the *Globe* case should be deferred pending the outcome of any investigation that may be made in the Third Circuit is, of course, a matter entirely for your Honor's determination. May we say, however, on behalf of Globe, that we should prefer to have the issues already litigated here decided on the record before this Court at the present time, leaving other questions for future determination. However, we wish to make it clear that we do not consider Universal's present withdrawal of the Root decision as a precedent as in any way absolving Universal from the legal consequences of unclean hands should its unlawful conduct in the Root decision ultimately appear. In that event, we shall, of course, in accordance with our duty to this Court, bring the matter to its attention by appropriate procedure, no

matter which way this Court's decision on the merits shall have gone.

I am sending a copy of this letter and of the enclosed Petition and Brief, *Amici Curiae*, to Mr. Reichmann.

Yours very truly,
(Signed) J. BERNHARD THIESS.

JBT:AED

CC: A. F. REICHMANN, ESQ.,
PAM, HURD & REICHMANN,
231 S. LaSalle Street,
Chicago, Illinois.